UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,210	06/24/2003	David B. Griep	066042-9326-00	2237

23409 7590 01/12/2006

MICHAEL BEST & FRIEDRICH, LLP
100 E WISCONSIN AVENUE
MILWAUKEE, WI 53202

EXAMINER	
PETERSON, KENNETH E	
ART UNIT	**PAPER NUMBER**
3724	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/602,210	GRIEP ET AL.	
	Examiner	Art Unit	
	Kenneth E. Peterson	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *20-33,36,37,39-41 and 44-67* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *20-33,36,37,39-41 and 44-67* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 20-33,36,37,39-41,44-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight '813, who shows an output spindle (127), a pinion (114), a gear (116), a hub (120), an eccentric (125) and a driving arm (126).

There is a selective transmission of force between the gear and the hub, as described on lines 28-34 of column 3. However, this clutch is not the same type as Applicant's clutch. In the first action , Examiner took Official Notice that it is well known for machines to employ a toothed rubber member between opposed, protrusioned elements for the purpose of protecting the drive mechanism. The examiner provided the patents to King et al.'368 and Iwabuchi et al.'981, who actually shows the hub and resilient member in a gear pocket. The Applicant has challenged this, and now the Examiner provides Palm '023 as a further example in support of the taking of Official Notice. In figure 7, Palm shows a hub (710), gear (716) and rubber elements (722) for absorbing impact energy and protect the drive and other sensitive parts (lines 41-47, column 6 and lines 40-52, column 8). It would have been obvious to one of ordinary skill in the art to have modified Knight's gear-hub clutch by making it of the type having the hub and toothed resilient member in a gear pocket with opposed, protrusioned elements, as is well known and taught by Palm, King and Iwabuchi, since this is an art recognized equivalent known for the same purpose of protecting the drive mechanism.

In regards to claim 30, King teaches that any number of protrusions would work (lines 54-59, column 3).

Knight's driving arm (126) meets the recitations of the claims, but Examiner notes that is not the same type as Applicant's driving arm (58). Examiner takes Official Notice that such driving arms are quite common. It would have been obvious to one of ordinary skill in the art for Knight to have employed a driving arm similar to Applicant's, since they are common and are art-recognized equivalents to Knight's driving arm. Applicant has not challenged this particular taking of Official Notice, and thus it is now taken as fact.

2. Applicant's arguments have been fully considered but they are not persuasive.

Applicant notes that Knight's drive protection mechanism is a slip clutch, whereas King's and Iwabuchi's drive protection mechanisms are flexible couplings, and argues that it is not obvious to exchange one for the other. However, these patents are all deemed to share a common field of endeavor, namely protecting the drive from the impacts of the driven, and thus they are considered to be equivalents known in the art. This equivalency is exemplified well by Palm, who shows that you have a choice between a slip clutch (embodiments of figures 1-6) and a flexible coupling (figure 7) and that either is an acceptable solution.

Applicant notes that King and Iwabuchi do not specifically mention saws, but instead example a window motor, fans, packaging machines, pumps and "various machines or devices". Applicant then argues that King and Iwabuchi are non-analogous

art and not combinable with Knight. However, Knight clearly expresses the desire to protect his drive, and Examiner thus deems it to be one of the "various machines or devices" that could be protected by the flexible couplings of King or Iwabuchi. This obviousness is exemplified well by Palm, who shows that it *is* obvious to employ a flexible coupling in a reciprocating saw (figure 7).

If Applicant is unable to grasp the obviousness of replacing a slip clutch with a flexible coupling, then consider an alternative rejection, where the base reference is a generic reciprocating saw, for example Feldmann et al.'125 or something similar. The teaching of Palm could modify this to meet at least some of the claims, without any need for a slip clutch in the base reference.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 571-272-4512. The examiner can normally be reached Mon-Thurs, 7:30AM-5PM

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KP
January 6, 2006

KENNETH E. PETERSON
PRIMARY EXAMINER